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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,997	12/09/2003	Charles A. Rosenblatt	05793.3125	2800
22852	7590	08/03/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER TROTTER, SCOTT S	
			ART UNIT	PAPER NUMBER
			3694	
			MAIL DATE	DELIVERY MODE
			08/03/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/729,997

**Applicant(s)**

ROSENBLATT ET AL.

**Examiner**

SCOTT S. TROTTER

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 13-41, 44-72 and 75-99 is/are pending in the application.
- 4a) Of the above claim(s) 21-31, 52-62 and 83-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-20, 32-41, 44-51, 63-72, 75-82, and 94-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the amendment filed May 24, 2010. Claims 1-10, 13-41, 44-72 and 75-99 are currently pending. Claims 21-31, 52-62, and 83-93 are withdrawn. This rejection is **Final**.

#### ***Response to Arguments***

2. The examiner thanks the applicant for noting the typographical errors in the previous office action and has tried to fix them in this one.
3. Regarding a contract being formed the Macaulay reference is going to if there was no contract formed then there is no exchange of goods or services. There is only an exchange if a contract is formed.
4. All arguments were considered but were not found persuasive.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7, 8, 13, 14, 32-36, 38, 39, 44, 45, 63-67, 69, 70, 75, 76, 94, 96, and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda in view of Macaulay ("Contracts Law in Action", Copyright 1995 by The Michie Company, pages 814-817; hereafter Macaulay).

As per claim 1 Masuda teaches:

A method for marketing a credit card account to a consumer, the method comprising:

receiving an application for the credit card account from the consumer through a point-of-sale location; (*See at least Masuda column 3 lines 51-53*)

receiving a notification that the consumer requests to purchase a product at the point-of-sale location; (*See at least Masuda column 3 lines 51-53*) and

determining, in a computer system, whether to approve the application based on the notification that the consumer requests to purchase the product; (*See at least Masuda column 51-53. Asking to make a credit purchase starts the application process making it an inherent part of determining whether to approve the application.*) and

causing the point-of-sale location to prevent the consumer's purchase of the product if the application for the credit card account received from the consumer through the point-of-sale location is not approved. (*See at least Masuda column 4 lines 3-7 and column 3 lines 51-53. Requesting to pay with credit using a credit card to be issued or denied at the store.*)

While Masuda does not explicitly teach that the denial of the application will not allow the purchase to be made Macaulay teaches having a contract with a way out such as confirming the customer's creditworthiness. (*See at least Macaulay at least page 814 the paragraph starting under section D.*) They also teach that the denial of a contract can prevent the delivery of the bargained for goods. (*See at least Macaulay at least page 815 the part of the case that appears on the page.*) Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made that

the denial of a credit application for the card that was part of the contract could result in the cancellation of the contract including the denial of the goods that had been bargained for if the contract had been fulfilled.

As per claim 2 Masuda teaches:

The method of claim 1, wherein receiving the application further comprises receiving information about the consumer sufficient to perform a consumer credit analysis. (*See at least Masuda column 3 lines 32-39*)

As per claim 3 Masuda teaches:

The method of claim 1, wherein receiving the notification further comprises determining, as a result of receiving the application that the consumer requests to purchase the product. (*See at least Masuda column 51-53. Asking to make a credit purchase starts the application process making it an inherent part of determining whether to approve the application.*)

As per claim 4 Masuda teaches:

The method of claim 1, wherein the notification and the application are received together. (*See at least Masuda column 3 lines 51-53. They start the transaction together.*)

As per claim 5 Masuda teaches:

The method of claim 4, wherein receiving the application includes: receiving the notification that the consumer requests to purchase the product. (*See at least Masuda column 3 lines 51-53. They start the transaction together.*)

As per claim 7 Masuda teaches:

The method of claim 1, further comprising: notifying at least one of the consumer and the point-of-sale location that the application has been approved. (*See at least Masuda column 3 lines 58-column 4 line 7*)

As per claim 8 Masuda teaches:

The method of claim 1, wherein determining whether to approve the application further comprises: performing a credit analysis at least using information associated with the consumer. (*See at least Masuda column 3 lines 57-58*)

As per claim 13 Masuda teaches:

The method of claim 1, further comprising: charging a purchase cost of the product to the credit card account. (*See at least Masuda column 3 lines 51-53. Paying with a credit card to be issued to make the purchase inherently requires charging the costs to the credit card.*)

As per claim 14 Masuda teaches:

The method of claim 1, wherein the credit card account is configured for use in subsequent purchase transactions unrelated to the product. (*See at least Masuda column 1 lines 38-53. Credit cards can be used for unrelated purchases which are one reason why they are issued instead of the installment plans disclosed at column 1 lines 15-37.*)

As per claim 94 Masuda teaches:

The method of claim 1, further including:

offering the credit card account to the consumer at the point-of-sale location.

(*See at least Masuda column 2 lines 23-26*)

As per claims 32-36, 38, 39, 44, 45, 63-67, 69, 70, 75, 76, 96, and 98 they are parallel system and computer readable medium claims and are rejected under the same rationales as their parallel method claims were rejected under above.

7. Claims 6, 9, 10, 37, 40, 41, 68, 71, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda in view of Macaulay and case law.

As per claim 6 Masuda teaches:

The method of claim 1, wherein the notification and the application are received separately. See MPEP 2144.04 [R-6] .IV.C. In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results) Therefore it would have been prima facie obvious to split up the notification and application steps.

As per claims 9 and 10 Masuda teaches the method of claim 1 as for the rest of the claim there are only two options if the product is not purchased either to approve the application anyway or deny it therefore it would have been obvious to a person of ordinary skill in the art at the time invention was made to try both to see which provided a greater benefit.

As per claims 37, 40, 41, 68, 71, and 72 they are parallel system and computer readable medium claims and are rejected under the same rationales as their parallel method claims were rejected under above.

8. Claims 15-20, 46-51, 73, 74, and 77-82, are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda in view of Macaulay, Foss (Automatic Bill Payment offers convenience, punctuality by Bradley Foss, Daily Breeze, Torrance, Calif., March

19, 2001; hereafter Foss), Sasso (Phone Companies' Plans Challenge Wireless Providers, by Michael Sasso, Knight Ridder Tribune Business News, March 9, 2003; hereafter Sasso), and Commerce (Temporary suspension of service due to overdue bill for the CBD Printing Fee, Commerce Business Daily, August 13, 2001, page 1; hereafter Commerce).

As per claims 15-20, Masuda teaches the method of claim 1. Masuda does not teach using an automatic draft to a credit card to pay bills. Foss teaches paying bills by automatic payment using credit cards and includes telephone bills such as AT&T and assumes funds are in the account for it to be usable the ordinary meaning of both closed and delinquent would be no money in the account. While Foss does not make explicit that AT&T is also a cell phone company Sasso makes clear that AT&T also offers an AT&T wireless service. While none of the previous references are explicit about denying service to people that don't pay their bills Commerce is a listing of agencies that will not be allowed to use a printing service for failing to pay their bill. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made that a service that was not being paid for could be denied and that an account that was closed or delinquent could not be used to pay a bill.

As per claims 46-51, and 77-82 they are parallel system and computer readable medium claims and are rejected under the same rationales as their parallel method claims were rejected under above.

9. Claims 95, 97 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda in view of Macaulay, Li (Card issuers' freebies offer expected to last till



year-end, by Kang Siew Li, Business Times, Kuala Lumpur, July 11, 2001, page 4 hereafter Li previously cited in 5/05/2008 office action conclusion).

As per claim 95 Masuda teaches:

The method of claim 1, further including:

offering the product to the consumer at the point-of-sale location; (*See Masuda column 3 lines 51-53*) and

conditioning the offer of the product to the consumer based on:

the consumer's acceptance of the credit card account, and

the customer's agreement to charge purchases and fees to the credit card account, including a charge associated with a purchase of the product. (*See Masuda column 51-53*. Asking to make a credit purchase starts the application process making it an inherent part of determining whether to approve the application.)

Li teaches offering giveaways for signing up for credit cards. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to require the acceptance of a credit card account to receive a product in return.

As per claims 97 and 99 they are parallel system and computer readable medium claims and are rejected under the same rationales as their parallel method claims were rejected under above.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication from the examiner should be directed to Scott S. Trotter, whose telephone number is 571-272-7366. The examiner can normally be reached on 8:30 AM – 5:00 PM, M-F.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. The fax phone number for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final  
Communications labeled "BOX AF")

Art Unit: 3694

(571) 273-6705 (Draft Communications)

sst

8/2/2010

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694